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Paper No. 7

Peter C. Richardson
PFIZER INC
235 East 42nd Street
New York NY 10017-5755

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AUG 23 2002

OFFICE OF PETITIONS

In re Application of :
Ryan :
Application No. 09/992,301 : ON PETITION
Receipt Date: February 6, 2002 :
Attorney Docket No.: 2089CON2 :
For: APPARATUS AND METHOD FOR :
SEALING AND CUTTING TISSUE :

This is a decision on the petition under 37 CFR 1.182, filed February 15, 2002 (Certificate of Mailing date of February 6, 2002) in response to the Notice of Omitted Item(s) in a Nonprovisional Application ("Notice").

The application was filed November 14, 2001. The Notice, mailed December 6, 2001, indicated that the application had been granted a filing date but that Figure 17 as described in the specification appeared to have been omitted from the application.

The Notice permits applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the Notice (37 CFR 1.181(f)).

Petitioner states that the instant application claims the benefit of priority to U.S. Pat. App. No. 09/591,328 which in turn claims the benefit of priority to U.S. Pat. App. No. 08/925,805. Petitioner further states that the instant application was intended to be a complete copy of the original parent application, but that Figure 17 was mistakenly not included with the application as filed November 14, 2001. Petitioner has included with the instant petition a drawing sheet containing Figure 17.

Petitioner argues that while Figure 17 was not included with the application papers filed November 14, 2001, Figure 17 is part of the disclosure of the instant application because Figure 17 was included with the filing of the original parent application, U.S. App. No. 08/925,805, to which the instant application claims priority. Petitioner has included a copy of the parent application in which Figure 17 is present.

Petitioner's arguments have been considered and found unconvincing. The application transmittal letter submitted November 14, 2001 does indicate that the instant application is a continuation of prior application Serial No. 09/591,328 filed June 9, 2000 which is a continuation of prior application Serial No. 08/925,805 filed September 9, 1997. However, there was no incorporation by reference of the disclosure of application No. 08/925,805 into the disclosure of the present application on November 14, 2001.

Petitioner's attention is directed to MPEP 201.06 wherein it states in pertinent part that as a safeguard against inadvertent omissions of prior application papers, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. However, a priority claim under 35 U.S.C. 120 in a continuation or divisional application does not amount to an incorporation by reference of the application(s) to which priority is claimed. For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. See, In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973) and Dart Industries, Inc. v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).

There is nothing in the language cited in the application transmittal letter as-filed or any of the application papers as filed incorporating the disclosure of either application No. 09/591,328 or application No. 08/925,805 into the instant application. The mere reference to another application is not an incorporation of anything therein into the application containing

the reference.

The petition is accordingly **DISMISSED**.

However, as petitioner seeks to add Figure 17 to the above-identified application on the basis that the drawing does not contain new matter, petitioner should be aware that no petition is necessary in this regard. New drawings may be entered by the primary examiner without a petition so long as the drawings do not contain new matter. See, MPEP 608.02(a). Petitioner is advised to file an amendment requesting entry of Figure 17. Any such amendment should be filed prior to the issuance of a first Office action on the merits to avoid further delay in prosecution of the application.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is not a final agency decision.

Further correspondence with respect to this matter should be addressed as follows:

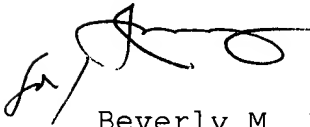
By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By facsimile: (703) 308-6916

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA 22202

This application is being forwarded to the Office of Initial Patent Examination with a filing date of November 14, 2001 and without the entry of Figure 17 in the record..

Telephone inquiries related to this decision may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy